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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,840	07/10/2006	Jean-Louis H. Gueret	05725.1484-00000	4272
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER GULLEDGE, BRIAN M	
			ART UNIT	PAPER NUMBER
			1612	
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			12/02/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,840

Applicant(s)

GUERET, JEAN-LOUIS H.

Examiner

Brian Guldedge

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-43 and 48-54 is/are pending in the application.
- 4a) Of the above claim(s) 48-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Previous Rejections

Applicants' arguments, filed August 12, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 18-19, 21-25, 27, and 34-36 stand rejected under 35 U.S.C. 102(b) as being anticipated by Clay (US Patent 5,775,344). Applicant argues that the rejection is not proper, as Clay does not teach a carrier with two non-occlusive application surfaces. Applicant also argues that Clay does not teach an energy source external to the carrier, but instead discloses an interior energy source (a battery).

The Examiner is not persuaded by these arguments. Clay teaches an applicator with two occlusive surfaces (see figure 1, **100**), which are on two opposing surfaces of applicator **10A-2**. And while Clay does teach a battery as the source of the energy, this battery is not part of the carrier. The carrier is the applicator, and the battery is integral to another part of the device (the container that holds the mascara), and is not integral with the applicator.

Claims 18-23, 25-26, and 29-30 stand rejected under 35 U.S.C. 102(b) as being anticipated by Strack et al. (US Patent 4,913,957). Applicant argues that the rejection is not proper, as the laminate taught by Strack comprises only one surface that can be impregnated with a cosmetic product.

The Examiner is not persuaded. First, the laminate taught by Strack does have two non-occlusive laminate surfaces (figure 1, **14** and **18**). Additionally, the claims do not recite that both surfaces must concurrently comprise the cosmetic, as stated, but that the carrier comprise two non-occlusive surfaces, and **14** and **18**, both essentially the same material as taught by Strack et al., meet the claimed limitation.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 18-20, 24, 26-27, 29-33, and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desnos (UK Patent Application Publication GB 2,321,443). Desnos discloses a container for epilatory wax that includes a lid and an application device, such as a spatula (abstract, lines 1-3). The applicator can include a thermochromatic material, such as an ink, that changes color when the wax is heated to the right temperature for application on the skin (abstract, lines 3-6). Desnos teaches that the wax is heated in the supplied container by means of a microwave oven in order to render the wax molten before the wax is applied to the skin (page 2, lines 1-9). One applicator disclosed by Desnos is a spatula made of plastic, which has two opposing sides, and the two sides are non-occlusive (non-absorbing) (page 5, line 22, –

page 6, line 5). Thus, Desnos teaches all of the limitations recited by instant claims 18-20, 24, 26-27, and 37-43.

The specific combination of features claimed is disclosed within the broad genera of applicators, method of heating, and thermochromatic materials taught by Desnos but such “picking and choosing” within several variables does not necessarily give rise to anticipation. *Corning Glass Works v. Sumitomo Elec.*, 868 F.2d 1251, 1262 (Fed. Circ. 1989). Where, as here, the reference does not provide any motivation to select this specific combination of variables, anticipation cannot be found.

That being said, however, it must be remembered that “[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious”. *KSR v. Teleflex*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraida v. A.G. Pro*, 425 U.S. 273, 282 (1976)). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious”, the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” (*Id.*). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR v. Teleflex*, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” *Id.* at 1742.

Consistent with this reasoning, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have selected various combinations of

applicators, method of heating, and thermochromatic materials from within the disclosure of Desnos to arrive at compositions “yielding no more than one would expect from such an arrangement”.

Claims 29-30 recite the temperature to which the cosmetic product is heated, and Desnos teaches heating the wax to between 44 and 58 °C (page 2, lines 27-29). This range overlaps the instantly recited ranges, and in cases involving overlapping ranges, the courts have consistently held that even a slight overlap in range establishes a *prima facie* case of obviousness. *In re Peterson*, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003).

Instant claims 31-33 recite durations of time which the cosmetic product is heated. While Desnos discloses heating the wax in a microwave to between 44 and 58 °C, Desnos does not disclose how long it will take to heat the wax to this temperature. However, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have determined how long the object would need to be heated in a microwave to reach between 44 and 58 °C by routine optimization.

Claim 28 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Clay (US Patent 5,775,344) in view of Poucher’s (“Poucher’s Perfumes, Cosmetics, and Soaps”, 10th Edition, 2000, pages 199-202). Applicant argues that Poucher’s does not rectify the deficiencies of Clay (see the above 102 rejection), and as such the rejection is not proper. This is not found persuasive, as discussed above.

Claims 31-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Strack et al. (US Patent 4,913,957). Applicant argues that the rejection is not proper, as Strack does not teach the instantly recited limitations with regards to the application surfaces (see the above 102 rejection). The arguments are not found persuasive, as discussed above.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gulledge whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BMG

/JEFFREY S. LUNDGREN/
Primary Examiner, Art Unit 1639